UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,476	06/19/2006	Christophe Martin	1032326-000394	3680

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EXAMINER
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ART UNIT	PAPER NUMBER
2164	

NOTIFICATION DATE	DELIVERY MODE
01/06/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Advisory Action **Before the Filing of an Appeal Brief**	*10/583,476*	MARTIN ET AL.
	Examiner	**Art Unit**	
	DANIEL KUDDUS	2164	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>27 December 2010</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

  a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

  b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

    Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

  (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

  (b)☐ They raise the issue of new matter (see NOTE below);

  (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

  (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

    NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

  The status of the claim(s) is (or will be) as follows:

  Claim(s) allowed: _____.

  Claim(s) objected to: _____.

  Claim(s) rejected: *11-20*.

  Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>see continuation sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Charles Rones/
Supervisory Patent Examiner, Art Unit 2164

With respect to applicant's arguments on pages 6-10, "combination cannot support a rejection of claim 11... claim 11 recites...(1) dividing a batch of data into a plurality of subsets, (2) preparing a first subset of data from the plurality of subsets (3) transmitting the first subset of data to a network server for backing up....the communication device 3 prepares a first subset of data including blocks 1-3 (3 of the 10 blocks) and then transmits the first 3 blocks (of the 10 blocks) to the server 2 for backup.... Claim 11 further recites... the backup is delayed by a predetermined period of time...and the backup of at least one other subset of data from the plurality of subsets subsequent to the first subset of data is resumed at the end of said predetermined period of time...no point is the information in the telephone book divided into different subsets for data transmission... the reference does not provide that a first subset from the telephone book (e.g., contacts with last names A-C) is transmitted for backup and then a second subset from the telephone book (e.g., contacts with last names D-F) subsequent to the first subset, is transmitted for backup after the first subset has been backup up and after a predetermined amount of time..... different transmissions are not directed to different subsets of the same set of data...SIM card is not divided for individual respective data transfers, nor is it backed up in manner similar to that of claim 1... Sarskog, Van Reenen is entirely silent with respect to....each subset from that batch of data...neither Sarskog nor Van Reenen, nor any combination teach...features...in claim 1... Neither, however, is analogous to the claimed method.... claim 11 is patentably distinct from Sarskog and Van Reenen... independent claims 18 and 19...recite at least some of the same...features...with respect to claim 11...withdrawn". Examiner respectfully disagrees. The limitations of the communication device 3 prepares a first subset of data including blocks 1-3 (3 of the 10 blocks) and then transmits the first 3 blocks (of the 10 blocks) to the server 2 for backup etc. are not recited in the claims. As such, the arguments are moot. Further, claim 1 has been cancelled for this present application. As such, the arguments directed to Sarskog nor Van Reenen, nor any combination teach...features...in claim 1 is not persuasive. Examiner will read that, these arguments are directed to claim 11. Sarskog in view of Van Reenen clearly teaches claim recites limitations. Sarskog teaches a method of backing up personal data of a wireless communication network subscriber (see figure 1, telephone 1, and 3, page 1, line 6-15, identify of the subscriber...mobile telephone with the mobile telephone system of a network operator), prepared a first subset of data from, and transmitted the first subset of data to a network server for backing up (see page 1, line 31 to page 3, line 18, information that has been stored in a so-called SIM card for mobile telephony (i.e. backup)....content of telephone book (i.e. telephone book has subset of data) is caused to be transferred to a computer, figure 1), the backup is delayed by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and the backup of at least one other subset of data, subsequent to the first subset of data is resumed at the end of said predetermined period of time (see page 2, line 1-6, page 2, line 25-30, content of the telephone book (i.e. telephone book has a subset of data) to the affiliated memory of a computer at predetermined time intervals (i.e. predetermined period of time) for safe storage of said information, via a mobile telephone system. The computer is caused to transfer said information content to a new SIM card replacement in response, via a mobile telephone system, column 2, line 1-6, telephone book is caused to be transferred...subsequent to given events, via a mobile telephone system).

Sarskog does not explicitly teach the the limitations of divided a batch of data to be backed up into a plurality of subsets, the plurality of subsets, from the plurality of subsets. Although, Sarskog teaches (see page 1, line 11-12, e.g. telephone numbers stored by the user). However, Van Reenen teaches clearly teaches such limitations (see page 2, line 13 to page 4, line 6, data that is backed up may be the names and telephone numbers stored in the telephone device, calendar data, addresses, files, notes, tasks, graphics and the like, page 4, line 14-16, telephone numbers associated with a subscriber accounts may then separate calls and their associate costs to the two groups). Note that, Sarskog teaches the limitation of predetermined period of time. As such, combine reference teaches claim recites limitations. Examiner indicates the references pre-dates the application, therefore qualifying as prior art and come from the same field as the application, therefore qualifying as analogous.

Applicant's argues on pages 10-14, "Dormehl in view of Jouenne...does not in any way...transmitted from the phone to the server...fail to disclose..claim 11....silent with respect to first dividing data in the mobile phone into a plurality of subsets, sending a first subset from the plurality of subsets from the divided data, waiting a predetermined amount of time, and sending another subset from the plurality of subsets.... at no point...Dormehl disclose dividing data into subsets and individually transmitting each subset from the divided data (i.e., one subset at a time) to the server for back up...make clear that the missing descriptive matter... Dormehl, Jouenne does not disclose first dividing information to be backed up into a plurality of subsets, sending a first subset from the plurality of subsets, waiting a predetermined amount of time, and sending another subset from the plurality of subsets, as recited in claim 11...cannot support prima facie case...for rejecting claim 11...claims 18 and 19...recite...some of the same...features...respect to claim 11...claims 12-17 and 20...distinct from the cited references". Examiner disagrees. The limitations of transmitted from the phone to server etc. are not recited in the claims. Dormehi in view of Jouenne clearly teaches claim recites limitations. Dormehi teaches the limitation of a method of backing up personal data of a wireless communication network subscriber, the personal data being memorized within a mobile communication device and backed up within network server (see abstract, page 2, line 1-14), wherein said method includes, in which, once the mobile communication device has divided a batch of data to be backed up into a plurality of subsets, prepared a first subset of data from the plurality of subsets and transmitted the first subset of data to a network server for backing up (see page 1, line 6-10, page 3, line 3 to page 4, line 18, figure 1, page 2, line 1-14, page 3, line 19-23, already stored....the operation requested by the relevant mobile telephone user, wherein replace said existing data with the uploaded data or to compare the uploaded data with the existing data and to update the existing data referred here as divided into a plurality of subsets), the backup is delayed by a predetermined period of time, so as to free the mobile communication device for a user of the mobile communication device and the backup of at least one other subset of data from the plurality of subsets subsequent to the first subset of data is resumed at the end of said predetermined period of time (see page 3, line 18-28, data stored in the relevant data base record under predetermined conditions (i.e. predetermined amount of time) by way of the internet; for release of the data stored in a data base record to be dependent upon the supply of security information; note that, since data stored in the relevant data base record under predetermined conditions by way of the internet and data is released 'dependent upon supply of security information', therefore mobile device can be free for predetermined period of time, which also teach delaying backup, page 5, line 9 to page 8, line 24, the database record may be subdivided into sub-records (i.e. plurality of subsets) if required so that data of a different nature can be separated out, page 2, line 1-4, backup procedure can..generally only be carried out (i.e. resume) when the mobile telephone and personal computer are physically present....when the user has access to the personal computer. Examiner reiterate previous explanation for the claim recites limitations, since, Dormehl teaches relevant database record release under predetermined condition, such as a PIN number or biometric identification data to the server, therefore, reference clearly teaches mobile device can be free for predetermined period of time, which also teach delaying backup). As such, Dormehl teaches claim recites limitations except for the limitation of an asynchronous backup. Jouenne teaches such limitation (see column 1, line 48-50, e.g. asynchronous type backup). Note that, Jouenne also teaches the limitation of the backup is delayed by a predetermined period of time, so as to free the mobile device for a

user of the mobile communication device; data is resumed at the end of said predetermined period of time (see column 3, line 64-67, transmission takes place either when no other call is expected between the stations, or else at the end of a predetermined time lapse, table 1).

  Therefore, taken alone or in combination of reference teaches claim recites limitations. Since, the references teach claim recites limitations, as such a proper prima facie case of obviousness has been established. The arguments by applicant's are not persuasive because of the reasons set forth on the final rejection mailed on August 27, 2010.

  Dependent claims rely on independent claims, such as dependent claims 12-17 and 20 depend on claims 11 and 19 and the rejections have been addressed in the detailed office action. The difference in objectives does not defeat the case for obviousness because, as MPEP § 2144 states, the "reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) …; In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).